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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,170	10/15/2001	Scott A. Rosenberg	03-380-D	3931
20306 7590 06/25/2007 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			EXAMINER JANVIER, JEAN D	
			ART UNIT 3622	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/978,170	<b>Applicant(s)</b> ROSENBERG ET AL.	
	<b>Examiner</b> Jean Janvier	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-11,13-18,20 and 21 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-11, 13-18 and 20-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **Response To Applicant's Arguments**

Although the Applicant admits, on page 10 and third paragraph of his 1.111 response, that Reilly teaches automatically disseminating information (display content or news pieces) and advertisements when predefined idleness criteria, such as not receiving an input from the user via the keyboard or mouse (period of non-activity), for a period of time (time delay) such as five minutes (preset by the user), however, the Applicant contends that Reilly does not teach entering a pause mode (idle time) **in response to a user input or action** (the user's decision not to enter or input or submit any request via a keyboard or mouse, coupled to a related computer system having the replay/display connected thereon, is considered an action; in other words, the user's decision not to do anything or input any information into the computer system is by itself an action) and, after entering the pause mode (idle time), displaying paused content (news pieces for thirty seconds) on a video display/replay (screen) during a time delay greater than zero second (i.e. 30 seconds) and, after the time delay (the 30 seconds) has elapsed, displaying an ad (for thirty seconds) on the video display (screen). Here, the Examiner completely and respectfully disagrees with the Applicant's findings. Indeed, the pause mode is equivalent to the idle period in Reilly and the user's action not to issue any command to the computer system via a keyboard or mouse is considered as the user's action or decision not to do anything. Having said that, Reilly teaches a system wherein the system enters a pause mode or idle time in response to a user's action or decision not to issue any command to the computer system for five minutes, for example, and displays news pieces (paused content) for thirty seconds/time delay (greater than zero second) on a display coupled to the computer system and, after the thirty seconds/time delay

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have elapsed, the system is further operable to display advertisements on the said replay or display screen for thirty seconds. See below.

“The present system relates generally to computer based information distribution systems and particularly to a system for distributing to a set of subscribers' computers information matching each subscriber's interests as well as advertising and for distributing the information and advertising to each subscriber's computer during time periods in which the subscriber's computer is otherwise inactive or during a pause (col. 1: 4-10). The system disseminates information and advertisements to subscribers' computers, wherein the information and advertisements are automatically displayed when the subscriber's computer is on, but meets predefined idleness criteria. For example, the predefined idleness criteria (pause conditions) could be the failure to receive any input for a period of at least five minutes, greater than zero seconds (col. 2: 28-34). The present system is also adapted to provide each subscriber or user with the ability to set up and change a user profile indicating categories and subcategories of topics, which are of interest and not of interest to the subscriber and to select the news stories displayed on the subscriber's computer accordingly (col. 2: 48-53).

Screen Saver and Viewer Procedures 200 of fig. 2 are a set of procedures for controlling the display of news stories and advertisements on the users' screens. These procedures include a main screen saver procedure 201, category managers 202, an animation engine 204, a profiler 206, a data viewer 208 and an advertisement display statistics generator 210 (col. 6: 62-67). Referring once again to FIG. 2, the animation engine 204 interprets a currently selected display script and controls the display of a selected set of news stories and an advertisement in accordance with the instructions in the currently selected display script (col. 7: 40-44). Screen

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saver information 219 of fig. 4 indicating the last displayed information category and the last displayed advertisement and news items in each information category is stored in a portion of the user profile 194, which is not transmitted to the information server; and a screen saver exit mode indicator 220 indicating what actions cause the screen saver procedure to terminate and what actions cause the data viewer 208 to be executed (this is the normal operation of any screen saver, which is usually set up by the end-user who selects the time delay or time period (in minutes) of non-activity that triggers the display of at least one screen saver in text and/or image format/mode-Col. 8: 10-18).

**In a preferred embodiment, the screen saver procedures for displaying news items (paused content) and advertisements are invoked using the same types of criteria as are used by other types of screen saver procedures (in which the end-user selects the screen saver he wants to be displayed during the non-activity period (pause) and sets the time delay or time period (in minutes) of non-activity that will trigger the display of at least one screen saver in text and/or image format/mode). Generally, whenever the system detects a lack of user inputs (user's action) or non-activity (pause) via either keyboard or pointer device (e.g., a mouse or trackball) for a user configurable or otherwise specified length of time (e.g., 5 minutes), the screen saver procedures of the present system begin the display of news items and advertisements from the local information database. In the preferred embodiment, the screen saver procedures display news items and advertisements for a sequence of information categories in a sequence of 30-second time slots (news items are displayed for 30 thirty seconds and, after the delay, the advertisements are displayed for 30 seconds) (Col. 11: 40 to col. 13: 25).**

See Col. 1: 22-34; col. 5: 8-34; col. 6: 16-61; col. 8: 45-67; col. 10: 56 to col. 11: 9 and claims 3, 4, 8 and 9 of the reference.”

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the current **Office Action has been made Final.**

### **DETAILED ACTION**

#### ***Specification***

#### **Status of the claims**

Claims 1-2, 5-11, 13-18 and 20-21 are currently pending in the Instant Application.

#### **General Comments**

Short of issuing a 112(1) rejection, the third limitation of claims 1 and 20 is interpreted at best as - -pausing by the user a currently watched programming, which is still displayed or shown on the display/replay (as paused content), after a time delay an ad, such as a full page ad, is displayed on the display screen---. (See page 10 and third paragraph of the specification).

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-11, 13-18 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,740,549A.

As per claims 1-2, 5-11, 13-18 and 20-21, Reilly discloses an information and advertising distribution system. A remote server stores and updates a database of information items and advertisements. The information items and advertisements are each categorized so that each has an associated information category. A workstation or user computer (video replay system), remotely located from the data server or server, includes a display device, a communication interface for receiving at least a subset of the information items and advertisements from the data server database and local memory for storing the information items and advertisements received from the data server. An information administrator in each workstation establishes communication with the data server from time to time so as to update the information items and advertisements stored in local memory with at least a subset of the information items and advertisements stored by the data server. An information display controller (pause module) in each workstation displays on the workstation's display device at least a subset of the information items and advertisements stored in local memory when the workstation (video replay system) meets predefined **idleness (pause) criteria or conditions**. At least, a subset of the workstations includes a profiler for storing subscriber profile data. The subscriber profile data represents subscriber information **viewing preferences**, indicating information categories for which the subscriber does and does not want to view information items. The information display controller includes a filter for excluding from the information items displayed on the display device those information items inconsistent with the subscriber profile data (See abstract).

The present system relates generally to computer based information distribution systems and particularly to a system for distributing to a set of subscribers' computers information matching each subscriber's interests as well as advertising and for distributing the information and advertising to each subscriber's computer during time periods in which the subscriber's computer is otherwise inactive or during a pause (col. 1: 4-10). The system disseminates information and advertisements to subscribers' computers, wherein the information and advertisements are automatically displayed when the subscriber's computer is on, but meets predefined idleness criteria. For example, the predefined idleness criteria (pause conditions) could be the failure to receive any input for a period of at least five minutes, greater than zero seconds (col. 2: 28-34). The present system is also adapted to provide each subscriber or user with the ability to set up and change a user profile indicating categories and subcategories of topics, which are of interest and not of interest to the subscriber and to select the news stories displayed on the subscriber's computer accordingly (col. 2: 48-53).

Screen Saver and Viewer Procedures 200 of fig. 2 are a set of procedures for controlling the display of news stories and advertisements on the users' screens. These procedures include a main screen saver procedure 201, category managers 202, an animation engine 204, a profiler 206, a data viewer 208 and an advertisement display statistics generator 210 (col. 6: 62-67). Referring once again to FIG. 2, the animation engine 204 interprets a currently selected display script and controls the display of a selected set of news stories and an advertisement in accordance with the instructions in the currently selected display script (col. 7: 40-44). Screen saver information 219 of fig. 4 indicating the last displayed information category and the last displayed advertisement and news items in each information category is stored in a portion of the



user profile 194, which is not transmitted to the information server; and a screen saver exit mode indicator 220 indicating what actions cause the screen saver procedure to terminate and what actions cause the data viewer 208 to be executed (this is the normal operation of any screen saver, which is usually set up by the end-user who selects the time delay or time period (in minutes) of non-activity that triggers the display of at least one screen saver in text and/or image format/mode-Col. 8: 10-18).

In a preferred embodiment, the screen saver procedures for **displaying** news items (paused content) and **advertisements** are invoked using the same types of criteria as are used by other types of screen saver procedures (in which the end-user selects the screen saver he wants to be displayed during the non-activity period (pause) and sets the time delay or time period (in minutes) of non-activity that will trigger the display of at least one screen saver in text and/or image format/mode). Generally, whenever the system detects a lack of user inputs (user's action) or non-activity (pause) via either keyboard or pointer device (e.g., a mouse or trackball) for a user configurable or otherwise specified length of **time** (e.g., 5 minutes), the screen saver procedures of the present system begin the **display** of news items and **advertisements** from the local information database. In the preferred embodiment, the screen saver procedures **display** news items and **advertisements** for a sequence of information categories in a sequence of 30-second **time** slots (news items are displayed for 30 thirty seconds and, after the delay, the advertisements are displayed for 30 seconds) (Col. 11: 40 to col. 13: 25).

See Col. 1: 22-34; col. 5: 8-34; col. 6: 16-61; col. 8: 45-67; col. 10: 56 to col. 11: 9 and claims 3, 4, 8 and 9 of the reference.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patent 5, 959, 621 to Nawaz** discloses a system for displaying data items in a ticker display pane (dynamic component) on a client computer or computer workstation or target system 184 wherein a user's client computer 184 receives from at least one or more sources or service providers over the Internet (global communication network) data including data items and/or advertisements (stream data) to be displayed on a ticker pane 142 of fig. 3 on a screen desktop 104 of fig. 3 associated with the client computer 184 and wherein the data or data items are displayed in a sequence where the data items or stream of data 150, 152, 154 and 156 are being replaced or updated on the ticker display pane 142 so as to display data item 156 on the first end 170 until the last data item 150 on the second 172 and the sequence restarts until the last data item is displayed on the ticker pane. Here, the data items are displayed on the ticker pane in a substantially continuous manner. Furthermore, the data items are being replaced or updated on a scheduled basis in an effort to have up-to-date information, downloaded directed from the content providers, displayed on the ticker pane 142 on a substantially continuous basis. In addition, stream of data 150, 152, 154 and 156 (identifier or content teaser) displayed within the ticker display pane 142 can contain hyperlinks to link the user or the customer to the original sources or providers of the information or data or full content related to the data items or identifiers 150, 152, 154 where he can receive more detailed information or full content directly from a source or content provider upon clicking on a hyperlink within a content teaser or identifier or data item 150 to thereby visit the source or content provider's web site. For instance,

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source identifier 144 of fig. 3, identifying the source or the provider (ESPN) of the stream of data or data items 150, 152, 154 and 156, displays an image associated with the source of the data items currently displayed on the ticker display pane 142 and may also include a hyperlink, which upon activation by the user or customer causes the system to retrieve and display a document on a server computer or host (**web page**) corresponding to the hyperlink wherein the displayed information or full document may represent advertising information. The source identifier 144 may further be an HTML page, **displayed on a web page**, allowing the content provider to place advertisements and other information in a display space for the source identifier (See abstract; figs 3-4 and 7; col. 3: 20 to col. 4: 9; col. 8: 14 to col. 9: 8). Finally, the user or the customer can customize the ticker display pane 142 (dynamic component) using the option button 160 of fig. 3 that allows the user or customer to, for example, customize provided content or to select information sources; otherwise the system or the host or server system will control how the data items or content teaser should be displayed in the ticker display pane 142 and select which information sources will provide the data items (host customizes dynamic component) (col. 9: 37-48; claim 6 of the current reference). It is herein understood that the user's computer is coupled to a web site (first web site), over a computer network or the Internet, where data items or content teasers or identifiers can be downloaded or retrieved in real-time from sources or content providers (content web sites) and displayed on the user's computer and wherein, upon clicking on a hyperlink embedded within a content teaser or identifier or data item, the user or customer can visit the source or content provider's web site (first content web site) to request or receive full content or full document, such as full sport news, associated with a content teaser or sport news headline from ESP network that was selected or activated by the user or customer.

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**Applicant's amendment** necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

06/11/07

JDJ

Jean D. Janvier

Patent Examiner

Art Unit 3622

JEAN D. JANVIER  
PRIMARY EXAMINER

